



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:) Date: July 19, 2004
Eric A. Belec et al.) Attorney Docket No.: F-444
Serial No.: 09/036,219) Customer No.: 00919
Filed: December 24, 2001) Group Art Unit: 3724
Confirmation No.: 5243) Examiner: Ghassem Alie
Title: MAILPIECE PERFORATING/CUTTING SYSTEM

TRANSMITTAL OF APPEAL BRIEF (PATENT APPLICATION 37 CFR 1.192)

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith in **triplicate** is the **APPEAL BRIEF** in the above-identified patent application with respect to the Notice of Appeal filed on May 19, 2004.

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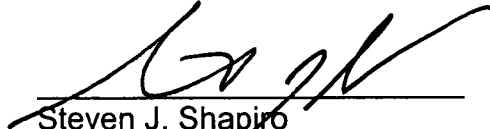
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Respectfully submitted,


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July 19, 2004
Date



PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
BOARD OF APPEALS AND PATENT INTERFERENCES**

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Eric A. Belec et al.) Attorney Docket No.: F-444
Serial No.: 09/036,219) Customer No.:00919
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Title: MAILPIECE PERFORATING/CUTTING SYSTEM

BRIEF ON APPEAL

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief, under 37 C.F.R. Section 1.192, is being filed in triplicate. The Appeal Fee in the amount of \$330.00 should be charged to deposit account number 16-1885, per Transmittal of Appeal Brief enclosed herewith. If the fees for this appeal are deemed to be insufficient, authorization is hereby given to charge any deficiency (or credit any balance) to deposit account number 16-1885.

REAL PARTY IN INTEREST

The real party in interest is Pitney Bowes Inc. which acquired all rights to the above-identified application by way of an assignment which was recorded in the Assignment Branch of the United States Patent and Trademark Office on June 4, 2002, at Reel 012969 and Frame 0885.

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RELATED APPEALS AND INTERFERENCES

There are no related Appeals or Interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the instant appeal.

STATUS OF CLAIMS

This Application is on Appeal, pursuant to 35 U.S.C. Section 134, from the rejection of claims 1 and 8 dated January 21, 2004. The instant application was originally filed with claims 1-9. An Election of Claims was filed on June 1, 2003, electing claims 1-2 and 8. In the Amendment filed October 31, 2003, claims 1 and 8 were amended and claim 2 was cancelled. In the Amendment After Final filed on April 16, 2004, claim 1 was cancelled and claim 8 was amended. In an advisory action mailed May 7, 2004, the Examiner indicated that the Amendment After Final filed on April 16, 2004, would be entered for purposes of Appeal. Accordingly, claim 8 is currently pending.

STATUS OF AMENDMENTS

An Amendment After Final is being filed concurrently herewith to correct a minor informality in claim 8. This Amendment After Final obviates an outstanding rejection of claim 8 under 35 U.S.C. 112, second paragraph, that was erroneously not corrected in the last response. Since the Amendment After Final is consistent with the Arguments set forth by the Applicants and doesn't require additional search time by the Examiner or raise any new substantive issues, Applicants have assumed for the purposes of this brief that it will be entered. Accordingly, pending claim 8 is being appealed and is set forth in Appendix A.

SUMMARY OF THE INVENTION

The instant invention is directed to a device for cutting a mailpiece 87 that results in the mailpiece 87 having a castellated appearance at its bottom edge, as shown in Figure 12. The castellated mailpiece 87 has uncut edge segments 869 which retain the contents of the mailpiece therein while the edge openings 867

permit any powder material to pass therethrough during a subsequent jogging or compression/decompression operation applied to the castellated mailpiece 87. This inventive cutting device thus provides an efficient way for potential contaminants that are being processed through the mail to be easily detected. Such detection is considered very important in view of recent events where biological agents were sent via the mail to Congress.

As reflected in Figure 12, the inventive device includes a cutter wheel 859 that having vertically extending cutting edges 861 at each side of notches 855. Further, the device includes a circular urethane wheel 862 (backing member) that has been mounted on shaft 845 directly below a cutter wheel 805 to rotate therewith. Accordingly, as the mailpieces 87 pass between a nip 863, defined between the outer edge 847 of cutter wheel 859 and the outer edge 849 of cutter wheel 805, the mailpiece is cut in the manner shown in Figure 11 to cut slits 851. However, as the mailpiece 87 passes between the nip defined between the cutting edges 861, that extend vertically down from the outer edge 847, and the backing member 862, the bottom of the mailpiece 87 is cut in a castellated appearance as shown in Figure 12. The result is that the mailpiece 87 has a plurality of segments 865 of the lower edge 864 removed to produce a plurality of edge openings 867 through which any powder material inside the mailpiece can pass while the non-opened portions 869 of the mailpiece 87 keep the contents of the mailpiece 87 contained therein.

ISSUES

At issue in this Appeal is the propriety of the rejection of claim 8 under 35 U.S.C. 102(b) as being anticipated by Yamauchi (U.S. Patent No. 6,119,568).

GROUPING OF THE CLAIMS

Claim 8 stands or falls by itself.

ARGUMENTS

In order for a rejection under 35 U.S.C. 102(b) to be valid, each and every element of the claimed invention must be taught by the prior art. In *re Bond*, 910 F.2d 831, 15 USPQ 2d 1566 (Fed. Cir. 1990). In the instant rejection, the Examiner admits that there is no teaching or suggestion that the cutting device of Yamauchi is configured in a manner to produce the claimed castellated appearance in the mailpiece as claimed. The Examiner simply states that the Yamauchi device "is capable" of creating a castellated appearance. The problem with this logic is that the Examiner is making this statement based on the teachings of the Applicants' specification and not on anything taught or suggested in the Yamauchi patent itself. Such hindsight use of the Applicants' teachings to provide the missing limitation of a reference is not permissible.

In addition to the above, the claimed second cutter wheel has vertical cutting edges 861 that extend perpendicular to and downward from the cutting edge of the cutter wheel 859. Yamauchi does not teach or suggest such vertical cutting edges. In Yamauchi, the Examiner refers to the edges 23, 24 of recess 21 as being the claimed vertical cutting edges. However, such is not the case. The edges 23, 24 do not extend downward from the cutting edge (no numeral) of the cutter wheel 18 but are contiguous therewith since they are the sides of the recess 21 formed on the cutting edge of cutter wheel 18. Put in another way, they are not a separate cutting surface from that of cutter wheel 18 but only reflect the thickness of cutter wheel 18. This is completely different than the claimed vertical cutting edges 861 which extend downward from the cutting edge 847 beyond its thickness. The Yamauchi device has a cutting wheel 18 that is similar to the cutting wheel 803 of the instant specification as shown in Figure 10 of the instant application. Cutter wheel 803 has a cutting edge 847 which has notches 855 cut therein. These notches 855 form a notched surface that is part of the cutting edge 847 and are contiguous therewith but do not have any separate vertical cutting

edges that extend downward from the edge 847 as the cutting edges 861 of Figure 12. This configuration produces the slits 851 in the mailpiece of Figure 11 which are similar to the elongated holes 7 of Yamauchi. Thus, as stated in Yamauchi, at column 6 lines 45-52, the cutter wheel 18 (including its recesses 21) only cut the sheet 2 to form the sides of the elongated hole 7. In order to cut the vertical portions of elongated hole 7, recess 21 interacts with an engaging portion 35 of cutter 32 to create the final elongated hole 7. Yamauchi never discusses creating a castellated edge appearance.

It is submitted that Yamauchi does not teach or suggest the claimed vertical cutting edges of the second cutter wheel that are substantially perpendicular to the second cutting edge and extend downward therefrom. Yamauchi also does not teach or suggest the claimed second nip defined between the backing member and the vertical cutting edges which is positioned relative to a mailpiece to create a castellated appearance in an edge of a mailpiece. The Examiner cannot render the claimed invention obvious because, in his opinion, after reviewing the Applicants' specification, he believes the applied reference could be used in a manner to create a castellated appearance even though Yamauchi doesn't teach or suggest such use. The Applicants' claimed interaction of its cutter wheels to produce the castellated mailpiece is clearly directed to patentable subject matter not taught by the applied references.

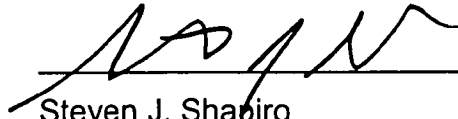
For the reasons set forth above, it is submitted that Claim 8 is neither anticipated by nor rendered obvious in view of Yamauchi.

SUMMARY

It is submitted for each of the reasons enumerated above that claim 8 is not anticipated by the applied references. Accordingly, the Appellants respectfully

request that the Board reverse the Examiner with respect to the 35 U.S.C. 102(b) rejection of claim 8 that is set forth in the Final Office Action.

Respectfully submitted,



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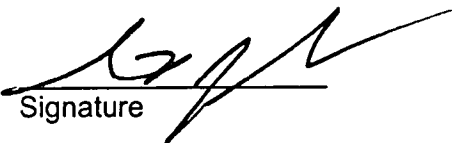
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Steven J. Shapiro (35,677)
Name of Registered Rep.


Signature

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APPENDIX A

8. A device for cutting mailpieces, the device comprising:
- a first cutter wheel having a first cutting edge;
 - a second cutter wheel having a second cutting edge, the second cutting edge having a plurality of notches therein and vertical cutting edges that are substantially perpendicular to the second cutting edge and extend downward from the second cutting edge, each of the plurality of notches having a pair of the vertical cutting edges each of which is disposed along a corresponding side of each of the plurality of notches;
 - a backing member; and
 - means for driving the first and second cutter wheels and the backing member into rotation;
- wherein the first and second cutter wheels are positioned to define a first cutting nip between the first and second cutting edges and the vertical edges and the backing member define a second cutting nip therebetween such that at times when a mailpiece passes through the first cutting nip the interaction of the first and second cutting edges make a first cut in the mailpiece except when the plurality of notches are present at the first cutting nip and when the mailpiece passes through the second cutting nip the vertical edges make a second cut in the mailpiece substantially perpendicular to the first cut whereby after the mailpiece has completely passed through the first and second cutting nips it has an edge having a castellated appearance including opened edge portions and unopened edge portions.